

Group I - Claims 1-42, drawn to a composition comprising at least one organic polymer, at least one volatile solvent, and at least one nonvolatile solvent, classified in class 424, subclass 401.

Group II - Claim 43, drawn to a cosmetic process for caring for, making up or treating a keratin material, classified in class 514, subclass 772.4.

In addition, the Examiner requires an election of species (see Office Action p. 3):

- a) an election of one species of organic polymer (i.e., methylstyrene/2-ethylhexyl acetate, methylstyrene/2-ethylhexyl acrylate/isobutyl methylacrylate copolymers, etc.),
- b) an election of one species of volatile solvent (i.e., polydimethylsiloxanes, etc.)<sup>1</sup>, and
- c) an election of one species of nonvolatile solvent (i.e., wheatgerm oil, sunflower oil, corn oil etc.).

Applicant respectfully traverses the restriction and election requirements for at least the following reasons. However, to be fully responsive, Applicant elects, with traverse, the subject matter of **Group I, claims 1-42**, for prosecution on the merits. In addition, Applicant elects, with traverse, the following species:

- a) **methylstyrene/2-ethylhexyl acetate** as the species of organic polymer
- b) **isododecane** as the species of volatile solvent
- c) **isopropyl myristate** as the species of nonvolatile solvent.

The claims 1-12, 16, and 25-42 are believed to be readable thereon.

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<sup>1</sup> Applicant respectfully submits that the Examiner has mischaracterized "polydimethylsiloxanes" as a species of volatile solvent instead of a sub-species of nonvolatile solvent. See, e.g., claims 12 and 24, which classify polydimethylsiloxanes as a type of nonvolatile solvent silicone oil.

For a restriction requirement to be proper, the Examiner must show that a serious burden exists if all claims are examined together. M.P.E.P. § 803. Here, the Examiner has not shown that there would be a serious burden to examine the claims of Groups I and II together. Both Groups I and II relate to compositions comprising at least one organic polymer, at least one volatile solvent, and at least one nonvolatile solvent (See e.g., claims 1 and 43). In addition, both Groups I and II relate to compositions in the cosmetics field. Therefore, Applicant respectfully submits that examining all claims of Groups I and II together would not impose a serious burden.

In addition, the M.P.E.P. clearly and specifically instructs that "[i]f the members of the Markush group are *sufficiently few in number* or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct invention." M.P.E.P. § 803.02 (emphasis added). And in such a case, the Examiner "will not require restriction." (*Id.*). Therefore, Applicant respectfully submits that examining, at least, all of the members of the Markush group of claim 16 (i.e. the natural and synthetic esters of formula  $R_1COOR_2$ , which includes the currently elected isopropyl myristate as the species of nonvolatile solvent of item c) above) would not impose a serious burden.

Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction and election requirement and examine Groups I and II together.

If the Examiner chooses to maintain the restriction/election requirement, Applicant expects the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to

determine the patentability thereof, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C.

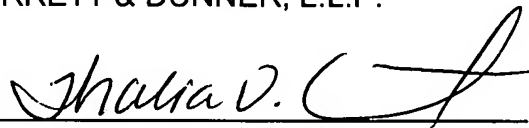
§ 121.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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